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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,307	07/15/2003	Humberto Herrera	HERH-002	7543
54556	7590	03/03/2006	EXAMINER	
INTELLECTUAL PROPERTY DEVELOPMENT JACK IVAN J'MAEV 14175 TELEPHONE AVE. SUITE L CHINO, CA 91710			BUGG, GEORGE A	
			ART UNIT	PAPER NUMBER
			2636	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,307	<b>Applicant(s)</b> HERRERA ET AL.	
	<b>Examiner</b> George A. Bugg	<b>Art Unit</b> 2636	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-4, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-9 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 10 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some    \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-4, drawn to a method of doing business, classified in class 705, subclass 500.
  - II. Claims 5-15, drawn to a method and apparatus for disabling a vehicle, classified in class 340, subclass 426.11.
  - III. Claims 16-17, drawn to a vehicle ignition computer, classified in class 340, subclass 540.
2. Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of doing business and the vehicle ignition computer are separate inventions and not required for the operation and functionality of the vehicle disablement system. The subcombination has separate utility such as a specific method of doing business, wherein the system is installed at the time of a government required inspection, and the vehicle ignition computer could be used for more than disabling the vehicle, such as remote start.

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3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Jack J'maev on 02/24/2006 a provisional election was made without traverse to prosecute the invention of Group II, claims 5-15. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-4, and 16-17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

5. Claim 10 is objected to because of the following informalities: the preamble contains the word "steps", but only a single step is recited. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

7. Claims 6-11, 12, 14, and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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8. Claims 6-10, 12, 14, and 15 recite the limitation "a vehicle computer", or "the vehicle computer" in 2<sup>nd</sup> line of claims 6-10, and the last line of claims 12, 14, and 15. There is insufficient antecedent basis for this limitation in the claim. The use of the words "a" and "the" is somewhat confusing because in all cases the independent claims 5 and 11 refer to "a vehicle ignition control computer", and then subsequent dependent claims recite either "a vehicle computer", or "the vehicle computer". It is unclear if Applicant is referring to the same computer, or a different computer. Amendment and/or clarification are needed properly utilizing the usage of the words "a" and "the", and using consistent terminology, in the event all claims are referring to "a vehicle ignition control computer". If the latter is true, then the claims should be written to reflect that Applicant is referring to the same computer. If not, then the claims should be written so as to eliminate any confusion regarding the vehicle ignition control computer, and some other computer, such as a vehicle ECM.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 5, 6, 8, 9, 11, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,937,823 to Reeder et al.

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11. With regard to claims 5 and 11, Figure 1, as well as column 1, line 58 through column 2, line 17, shows a disablement system 100 with a radio frequency receiver (104) electrically connected to a microprocessor (106) which in turn is connected to an ECM (116), which is connected to an ignition system (118). The circuit components given as 102, 116, and 118, make up the vehicle ignition control computer as claimed. It should also be noted that this passage states that the module 102 is mounted to a land vehicle. Column 2, lines 50-54, state that the memory (108) of the microprocessor (116) has a set of instructions stored thereon, for execution by the microprocessor, to control the engine of the vehicle. This set of instructions teaches that the system is both programmable, and contains the necessary firmware for operation. In addition, Figure 2, as well as column 3, lines 14-52, show the radio frequency receiver (104) receiving a shutdown page, which is equivalent to a disablement signal. Upon receiving this signal the system program is initiated, and as shown in block 216 of flowchart 200, the ignition is disabled.

12. With respect to claims 6 and 12, column 2, lines 32-43, disclose that the ECM (116) has an input terminal used to enable or disable the ignition system. The output of circuit 112 being input to the ECM and used to determine whether to enable or disable the ignition system, dependent upon the value of the voltage applied to the input of the ECM. It is therefore the contention of the Examiner that this input to the ECM is a diagnostic port. A decision or diagnosis as to enable or disable the ignition system is being made based on the information received at this input terminal. Furthermore, it has been previously shown that the system of Reeder is electrically connected to a land

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vehicle and its existing computer, further teaching that the radio receiver is connected to a diagnostic port of a vehicle computer.

13. As for claims 8 and 14, it has been shown above that the system of Reeder is not only used in conjunction with the ECM of a land vehicle, that it is also mounted on land vehicle. Electrical connections between the invention of Reeder and the vehicle computer have also been shown, thereby teaching that the radio receiver (104) has been integrated into the vehicle computer (116).

14. As for claim 9, it has been shown above that the system can be connected to a diagnostic port and that firmware can be conveyed to a vehicle computer for disabling an ignition system when a disablement signal is received.

### ***Claim Rejections - 35 USC § 103***

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,937,823 to Reeder et al.

17. With respect to claims 7 and 13, these claims merely recite an alternate connection means between the radio receiver and the vehicle computer. It is the contention of the Examiner that the recited connection does change the functionality of

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the system, but rather is an equivalent substitution for making the same physical electrical connection between components. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Reeder et al. to include alternate connections means, because to do so would make the system more versatile and easier to install.

### ***Allowable Subject Matter***

18. Claims 10 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

19. Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George A. Bugg whose telephone number is (571) 272-



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2998. The examiner can normally be reached on Monday-Thursday 9:00-6:30, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Hofsass can be reached on (571) 272-2981. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

George A Bugg  
Examiner  
Art Unit 2636

February 28, 2006



JEFFERY HOFSSASS  
SUPERVISORY PATENT EXAMINER  
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